

REMARKS

Claims 1-39 are cancelled. Claims 41, 44-45, 47, 51, 53, 56-57, 59, and 63 are subject to an affirmed rejection by the BPAI and the affirmance thereof are deferred until prosecution before the Examiner is concluded. Although all of the appealed claims are listed in the listing of claims above, only the claims rejected under new grounds are available for further prosecution here.

Claims 40, 42, 43, 46, 48-50, 52, 54, 55, 58 and 60-62 are pending in this application. Of these pending claims, Claims 40, 42, 43, 46, 48-50, 52, 54, 55, 58 and 60-62 stand rejected. The following remarks are believed to be fully responsive to the outstanding office action, and are believed to place the application in condition for allowance.

Claim Rejections – 35 U.S.C. § 103

Claims 40, 42, 43, 46, 48-50, 52, 54, 55, 58 and 60-62 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Motoyama ('388) reference, MS Word ("Working with Microsoft Word 6.0: Part II – The Art of Page Design", Smart Computing in Plain English, May 1995, pages 54-57), and the Griswold ('911) reference. This rejection is respectfully traversed.

Independent Claim 40 will be addressed as representative of independent claim 52. In the field of digital printing, printer operators often receive documents having a variety of different characteristics, such that different portions of the documents often need to be printed by different printing devices. For example, a document may include sections having only black and white text and other sections having color images. The printer operator may need to print the sections having only black and white text with black and white printers and the sections having color images with color printers. It is therefore desirable that the printer operator have the ability to designate on which printing devices the various pages of the composite document should be printed without compromising the integrity of the original electronic version. It is further desirable that the printer operator has the ability to group the pages destined for a specific printing device and print them together without printing pages associated with other printing devices. Since the pages destined for the same printing device may be non-consecutive, it is

desirable that the printer operator be able to designate a single group of images which includes both consecutive and non-consecutive pages that can be single pages or subgroups of pages.

The present invention addresses these problems by inserting group identifiers into electronic representations of the documents. The group identifiers establish one or more groups of pages each group of which can include consecutive and non-consecutive pages that can be single pages or sub-groups of pages and are used by software to allow a printer operator to selectively print these page groups with different printers. Claim 40 defines a method of operating a print system to print an electronically formatted document having a plurality of images. The method includes running a Print Document Management System (PDMS) program on a computer which receives the document into the Print Document Management System program. The method also includes displaying in the PDMS a Graphical User Interface ("GUI") which permits a print operator to assign group identifiers into the document to establish groups of pages in the document to thereby create an amended document, wherein a single group of pages can include both consecutive and non-consecutive pages that can be single pages or sub-groups of pages. Additionally, the method includes instructing the computer to send one or more of the groups of pages of the amended document to an output data stream for printing.

The Examiner on page 2 of the Office Action has stated "Applicant's amendments do overcome the references cited by the Board". These references include Motoyama and MS Word. The Examiner has also stated on page 4 of the Office Action "The combination of Motoyama and MS Word does not disclose expressly that said group of pages can also include non-consecutive pages". The Griswold patent is then cited as disclosing "grouping pages consecutively and non-consecutively (column 11, lines 7-16 of Griswold)" and that "the combination of Motoyama and MS Word is combinable with Griswold because they are from the same field of endeavor, namely the manipulation, editing and processing of digital document image data." The statements relating to Griswold are respectfully challenged. The claimed invention is not in the same field of endeavor as Griswold. The present invention relates to the field of printing and the control of a printer operator over the printing operation, i.e., the printers to be used and the grouping of pages to be sent to a printer to be either consecutive or non-consecutive. Motoyama is also in the printing field while MS Word allows a

user to format a word processing document that can be printed. Griswold is not in the printing field and thus is not properly combined with Motoyama and MS Word. It is submitted that one would not look to Griswold to solve the problems presented in the printing field.

Griswold relates to a method and system for computerized learning, response, and evaluation. There is no control of printers or the printing operation disclosed in Griswold. Moreover, the user in Griswold has no control over “the manipulation, editing and processing of digital document image data”, and no control over the ability to insert group identifiers on images displayed. The branching technique used in Griswold is established during the authoring mode when the learning software is developed. It is the software author that inserts control buttons (Griswold, Fig. 4, elements 64 and 68) on a page displayed to a user of the learning software, that allows the user to branch to non-consecutive pages (Griswold, Fig. 4, branch path 60). “The system also provides for branching of various points of the lesson. These branches are created in the authoring portion of the system------. When branch information is available it is indicated to the user through the use of a control button located on the page.” (Griswold, col. 7, lines 26 – 41). “The authoring portion allows a developer or author to have ultimate control over any and all pathways which a user of the lesson may potentially take.” (Griswold, col. 15, lines 23 – 26). There is no provision in Griswold for the user to insert group identifiers in pages displayed to the user. This is a key feature of the present invention. It is submitted that claim 40 is clearly nonobvious over the cited references.

The arguments above relating to the nonobviousness of Claim 40 are equally applicable to Claim 52 and the Claims dependent from Claims 40 and 52.

It is submitted that Claims 40, 42-43, 46, 48-50, 52, 54-55, 58, and 60-62 are nonobvious over Motoyama, MS Word and Griswold and should be allowed.

Since Claims 41, 44-45, 47, 51, 53, 56-57, 59, and 63 which had an affirmed rejection by the BPAI are dependent from allowable Claims 40 and 52, it is submitted that these claims should also be allowed. As stated in MPEP 1214.01; “Prosecution before the examiner of the 37 CFR 41.50(b) rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further prosecution.”

CONCLUSION

It is respectfully submitted that, in view of the above amendments and remarks, this application is now in condition for allowance, prompt notice of which is earnestly solicited.

The Examiner is invited to call the undersigned in the event that a phone interview will expedite prosecution of this application towards allowance.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.